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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1948.

No. 745

RICHMOND SCREW ANCHOR CO., INC., A CORPORATION,
Petitioner,

vs.

LAWRENCE H. UMBACH, Et AL.,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

RICHMOND SCREW ANCHOR CO.,
By **VICTOR E. LARUE,**
EUGENE A. TAPPY,
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INDEX.

	PAGE
Petition for Writ of Certiorari	1
Jurisdiction	3
Matter Involved	4
Patents Nos. 1,857,610 and 1,919,751	5
Patent No. 2,020,912	6
Patent No. 2,107,130	7
Patent No. 2,162,592	8
Patent No. 2,222,339	9
Questions Presented	10
Reasons Relied On for Allowance of Writ	12
1. The possibility of conflict between circuits is remote	12
2. Important questions of patent law have been decided in a manner in conflict with decisions of this court	12
3. Important questions not heretofore settled by decisions of this court	13
4. The reviewing court has departed from the accepted course of judicial proceedings	14
Conclusion	14
Brief in Support of Petition for Writ of Certiorari ..	15
Judgments of Courts Below	15
Jurisdiction	16
Statement of Facts	16
Specification of Errors to be Urged	16
Argument	18
Reasons Relied On for Allowance of Writ:	
I. Possibility of Conflict Remote	18
II. The Court of Appeals Has Decided Questions Concerning Patents Probably in Conflict With Decisions of This Court	20

III. Rule 52 (a) of the Federal Rules of Civil Procedure Was Not Followed by the Court of Appeals	21
1. Patents Nos. 1,857,610 and 1,919,751 ..	24
2. Patent No. 2,020,912	27
3. Patent No. 2,107,130	29
4. Patent No. 2,162,592	31
5. Failure to produce evidence	31
IV. The Court of Appeals Has Departed From the Accepted Course of Judicial Proceedings	33
Appendix:	
Claims 1 and 2 of Patent No. 1,857,610 and Claims 1 and 2 of Patent No. 1,919,751	35
Claim 3 of Patent No. 2,020,912—Claim of Patent No. 2,107,130—Claim of Patent No. 2,162,592	36

TABLE OF AUTHORITIES.

Cases.

Adamson v. Gilliland, 242 U. S. 350, 37 S. Ct. 169, 61 L. Ed. 356	13
Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68	13
Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527	13
Dixie-Vortex Co. v. Paper Container Mfg. Co., 130 F. 2d 569	24
Dubois v. Kirk, 158 U. S. 58, 15 S. Ct. 729, 39 L. Ed. 895	13
Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126, 86 L. Ed. 736	12, 19
Federal Trade Commission v. Cement Institute, 92 L. Ed. 806 (Adv. Sheets)	13, 22
General Electric Co. v. Leviton Mfg. Co., 31 F. Supp. 580	30
Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 93 L. Ed. 493 (Adv. Sheets)	12, 21
Levin v. Coe, 132 F. 2d 589	23
Mackay Radio & Telegraph Co. v. Radio Corporation of America, 306 U. S. 86, 99, 83 L. Ed. 506, 508 ...	12, 20
Miller v. Eagle Mfg. Co., 151 U. S. 186, 14 S. Ct. 310	12
Muncie Gear Works, Inc. v. Outboard, Marine & Manufacturing Co., 315 U. S. 759, 86 L. Ed. 1171	12, 19
Park-In Theatres, Inc. v. Rogers, et al., 130 F. 2d 745	28
Perfection Disappearing Bed Co., Inc., et al. v. Murphy Wall Bed Co., et al., 266 F. 698	29
Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co., 151 F. 2d 91	28

Reinharts, Inc. v. Caterpillar Tractor Co., 85 F. 2d 628	22
Ruben, et al. v. Ariston Laboratories, Inc., 40 F. Supp. 551	26
Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47, 83 L. Ed. 34	12, 20
Shipp v. Scott Township, Montgomery County, Ind., 54 F. 2d 1019	25
Suffolk Co. v. Hayden, 3 Wall. 315, 18 L. Ed. 76	12
Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co., 22 F. 2d 259	26, 27

Texts.

Walker on Patents (1937 Ed.) Vol. 1, Sec. 26; Vol. 3, Sec. 701	29
Wigmore on Evidence, Vol. 3, Sec. 285 (3rd Ed.)	32

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LAWRENCE H. UMBACH, Et AL.,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

*To the Honorable The Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Petitioners pray that a Writ of Certiorari issue to the United States Court of Appeals for the Seventh Circuit to review the judgment entered March 15, 1949 in:

Cause No. 9641 on the docket of said court wherein the petitioners were appellees.

This judgment relates to the following United States Letters Patent issued to Tamis C. Schenk and assigned to the petitioner. The patent number, date of issuance and subject matter of each patent is as follows:

No.	Date Issued	Subject Matter
1,857,610	5/10/32	"For an invention in a Form Tie."
1,919,751	7/25/33	"For an invention in a Wedge for Form Ties."

No.	Date Issued	Subject Matter
2,020,912	11/12/35	"For an invention of an improvement in a Form Tie."
2,107,130	2/ 1/38	"For an invention in a Means for Preventing the Formation of Continuous Voids in Concrete Masses."
2,162,592	6/13/39	"For an invention in a Form Tie."
2,222,339	11/19/40	"For an invention in a Form Tie."

The judgment was entered upon appeal taken by respondents from the judgment of the District Court of the United States for the Northern District of Illinois, Eastern Division.

The action was brought by petitioner, the Richmond Screw Anchor Co., Inc., Brooklyn, New York, as owner of the patents, charging infringement by respondents, Lawrence H. Umbach, Ruth M. Umbach and Bror Hillberg, a co-partnership doing business as the Superior Concrete Accessories at Chicago, Illinois.

The District Court:

1. Held valid but not infringed Patent No. 1,857,610 (R. 347).
2. Held valid and infringed Patent No. 1,919,751 (R. 347).

The Court of Appeals considered Patents Nos. 1,857,610 and 1,919,751 together and held:

"We think the conclusion is inescapable that the patentee disclosed nothing in No. 1,919,751 that had not been fully disclosed in No. 1,857,610 and for that reason we must hold it invalid." (R. 392.)

3. Held valid and infringed Patent No. 2,020,912. There are four claims in this patent (Vol. 1, Exhibits 49). The Court of Appeals held:

"In our judgment, this patent does not disclose invention and we hold its claim invalid." (R. 396.)

4. Held valid and infringed Patent No. 2,107,130 (R. 347). The patent has only one claim. The Court of Appeals held the claim invalid and not infringed (R. 400).

5. Held valid and infringed Patent No. 2,162,592 (R. 347). The patent has only one claim. The Court of Appeals held the claim of the patent invalid (R. 402).

6. Held valid and not infringed Patent No. 2,222,339. The Court of Appeals held it valid in its original opinion of January 18, 1949, but in its amended opinion of March 15, 1949, held it invalid (R. 402).

JURISDICTION.

This court has jurisdiction to review the judgments in question under Section 240 (a) of the Judicial Code, as amended by the Act of February 3, 1925, 28 U. S. C. 347 (a).

The judgment below was entered January 18, 1949. Petition for rehearing duly filed and denied March 15, 1949. Opinion amended on March 15, 1949.

MATTER INVOLVED.

The Schenk patents in the suit owned by the Richmond Screw Anchor Co., Inc. of Brooklyn, New York, by assignment cover form-tie rods, form-tie rod holder, water seal tie rod and a cone with spaced projections, that is, accessories used in connection with forms employed in constructing concrete walls such as walls for houses, water tanks and dams.

The action brought by the patent owner charges infringement by Lawrence H. Umbach, Ruth M. Umbach and Bror Hillberg, a co-partnership doing business as the Superior Concrete Accessories at Chicago, Illinois, manufacturers and sellers of equipment used in concrete construction.

Basically the controversy is this:

1. Can the Patent No. 1,919,751 be held valid and so made the basis of a charge of infringement by the petitioners? The District Court held the patent valid and infringed. The form-tie holder was claimed by name only in the first patent issued No. 1,857,610, and claimed by structure or in detail in the divisional patent No. 1,919,751. The respondents charged the petitioners with double patenting.

The Court of Appeals made the holding:

"We think the conclusion is inescapable that the patentee disclosed nothing in No. 1,919,751 that had not been fully disclosed in No. 1,857,610, and for that reason we must hold it invalid."

It did not reach the question of infringement.

2. Can the patent No. 2,020,912 be held valid and so made the basis of a charge of infringement by the peti-

tioners? The District Court held the patent valid and infringed. The Court of Appeals held one unidentified claim out of the four claims of the patent invalid. It did not reach the question of infringement.

3. Can Patent No. 2,107,130 be held valid and so made the basis of a charge of infringement? The District Court held the patent to be valid and infringed. The Court of Appeals held the claim invalid and not infringed.

4. Can Patent No. 2,107,130 be held valid and made the basis of a charge of infringement? The District Court of Appeals held the patent to be valid and infringed. The Court of Appeals held the claim invalid. It did not reach the question of infringement.

Patents Nos. 1,857,610 and 1,919,751.

The Court of Appeals disagrees with the trial court which held there was no double patenting in No. 1,919,751. The trial court found the second patent in suit discloses invention over Patent No. 1,857,610 (R. 345). The basis for the disagreement is that the patentee disclosed nothing in No. 1,919,751 that had not been fully disclosed in No. 1,857,610 (R. 392).

The applications for these patents were co-pending in the patent office and were by the same inventor. There are two structures, the tie-rod and the wedge. The wedge was disclosed in 1,857,610, where it was mentioned by name only, "Bottom-heavy wedge" in Claim 2 of 1,857,610. The wedge was claimed by structure in 1,919,751. The claims are placed side by side in the appendix attached hereto.

The division was made in the Patent Office as indicated by the letters patent No. 1,919,751, which states:

"This application is a division of my earlier application for form-ties filed May 1, 1931." (Vol. 1, Ex. 25.) (R. 177.)

During the trial No. 1,857,610 was dismissed out of the suit save the disclosures on the wedge as there was no infringement of the tie rod (R. 189).

The rule laid down in the opinion would preclude any division whatsoever in the patent office. The question is: May A, who seeks a patent upon a certain structure and discloses but does not cover by claim certain novel features therein, apply, within one year from the date of the original application for a new patent covering disclosed but unclaimed novel features when it appears that the second application was made before the patent on the first application was issued?

Patent No. 2,020,912.

The Court of Appeals held that an undisclosed claim is invalid as it does not disclose invention (R. 395). The court stresses the fact that the application met with rugged resistance in the Patent Office. The main issue with the reviewing court concerned the importance of an integral ring, which was formed on the rod, which was used as a stop to span the form boards used in producing a concrete wall. This stop in the patentee's form-tie rod is strong while other stops in the prior art were weak. The reviewing court has overlooked the fact that this stop insured the break-off within the wall and that it was easy to twist and snap. These tie-rods and other patents in the suit have been accepted in the trade, numbered in millions, proving themselves to be the nucleus of the concrete accessories business. The defendants' patent, Umbach, No. 1,907,618 was one of the patents which was before the Examiner and which was found by the Examiner not to anticipate the patent in the suit (Vol. 1, Exhibits 60-61, File Wrapper).

The rugged resistance which the application met in the

patent office should prove and not disprove invention. This is a new question which has never been decided by this court. It is akin to the presumption of invention which accompanies the issuance of a patent.

The Court of Appeals cites one, the Pinaud patent 2,095,814 stating it appears to be the most pertinent of prior art patents and it was not cited by the Patent Office (R. 394). The question is whether it is to be considered as a prior art publication. It was co-pending in the Patent Office with the patent in the suit. It was issued later than the patent in the suit as evidenced by its higher patent number.

Patent No. 2,107,130.

The Court of Appeals held this patent to be invalid but said it came closer to approaching a patentable status than any of the patents in the suit; that it was subject to stress in the Patent Office and Kahn Patent 768,284 is cited in anticipation (R. 398). The question is whether the fact that the Kahn Patent 768,284 was before the Examiner strengthened the presumption of validity.

This patent No. 2,107,130 was the only patent in the suit which the reviewing court held to be both invalid and not infringed. The lack of infringement was based upon petitioner's testimony (R. 234), which asserts there was no similarity between the petitioner's device and the alleged infringing device. Snyder, the petitioner's witness, did not see the disk or washer, that is to say, the center member of the elements. It was hidden between the two outer members. It was Umbach, one of the defendants, testifying for the defense, who supplied the hidden information concerning the disk or washer.

Thus the infringing device differs only with the patent in the suit in that it has enlarged two outer members and they are fused together. All other features are the same.

The purpose is the same in each instance, that is, to act as a barrier about which the water must flow to pass along the length of the rod. The test is do the parts although enlarged and fused instead of formed on the rod function the same as the two annular rings of the patent in the suit.

Patent No. 2,162,592.

The Court of Appeals declared the single claim of this patent to be invalid saying that it was an improvement which resided well within the area of mechanical skill. The opinion quotes features from a prior art patent, the Whitescarver, that by making the cone "corrugated" the walls of the recesses formed thereby are correspondingly corrugated to more readily anchor the cement filler in place (R. 401). The fallacy in the reasoning is assuming the corrugated cone of the Whitescarver patent is the same as the projection 4 in the patent in the suit. This prior art patent was before the Examiner (Vol. 1, Exhibits 107). The attorney for the patentee, as disclosed by the file wrapper, presented a brief to point out the dissimilarity between the device in the Whitescarver patent and the device in the application which presented the questions whether invention is present when a change in shape secures a new result and makes for more effective operation.

The prior art patents introduced by the defendants to prove the lack of novelty in this and the other patents in the suit consisted of over one hundred letters patent (Def. Ex. 12). With the exception of introducing a drawing of some of the drawings of these prior art patents to which the petitioner objected as secondary evidence (R. 316-318), the book of patents, the primary evidence, was not used during the trial. Umbach, as an inventor, who was familiar with the prior art, testified on the question of invention but made no mention of these letters patent. Ob-

viously, the trial court did not believe him on the questions of lack of invention, as he, with the other defendants, had been licensees of the Richmond Screw Anchor Co. of Brooklyn, New York, for eight years and as such licensees manufactured and sold the patented articles. His testimony was in conflict with the statements in his advertising concerning these patents. On the question of lack of novelty, the failure of Umbach to explain the prior art as it appears in the letters patent raises the question whether his failure to testify as to the prior art supports the inference that the tenor of such evidence would be unfavorable to the defendants' plea of lack of novelty.

Letters Patent 2,222,339.

The petitioner as plaintiff below on its own motion moved the trial court to dismiss Letters Patent 2,222,339 out of the complaint when it was learned the device submitted by the defendants was unlike petitioner's letters patent as it had flattened the rod. The trial court dismissed it accordingly. The reviewing court ordered it should have been dismissed out of the complaint.

QUESTIONS PRESENTED.

The questions presented are:

1. Whether claims one and two of Letters Patent 1,919,751 are valid and infringed?
2. Whether patentee who seeks a patent upon a structure and discloses but does not cover by claim certain novel features therein may apply, within one year from the date of the original application for a new patent covering disclosed but unclaimed novel features, when it appears that the second application was made before the patent on the first application issued?
3. Whether claims 1, 2, 3, and 4 of Letters Patent 2,020,912 are valid and infringed?
4. Whether the reviewing court may consider as lack of invention the fact that the application met rugged resistance in the Patent Office and the fact that it is an open question whether the Examiner finally gave his approval because of the merits of the invention or whether he succumbed to the persistency displayed by the patentee?
5. Whether letters patent issued subsequent to patent in the suit may be used as a prior publication to prove anticipation of the patent issued?
6. Whether the Pinaud Patent 2,094,814 issued later than 2,020,912 can be used as a prior publication to prove anticipation as to patent 2,020,912?
7. Whether the sole claim of Letters Patent 2,107,130 is valid and infringed?
8. Whether the presumption of validity may be overcome by reviewing of a single letters patent which is out-

side the prior art and has been rejected by the Examiner and the trial court as anticipating the patent in the suit?

9. Whether the sole claim of Letter Patent 2,162,592 is valid and infringed?

10. Whether the reviewing court in setting aside a finding of fact by the trial court may consider only a part of the testimony to prove infringement without considering the admissions of the infringer?

11. Whether invention is present when a change in shape secures a new result and makes for a more effective operation?

12. When an infringer, who is an inventor of similar devices, fails to testify to the prior art does such a failure raise an inference that the tenor of such evidence would be unfavorable to his defense of lack of novelty?

13. Whether the secondary evidence introduced by the defendant is *of itself* an admission that defendant's primary evidence was insufficient to sustain their defense of lack of novelty?

REASONS RELIED ON FOR ALLOWANCE OF WRIT.

The reasons relied on for the issuance of the writ prayed for are:

1. That the possibility of conflict between circuits is remote.

The trial court and the reviewing court have disagreed upon the validity and infringement of the patents Nos. 1,919,751, 2,020,912, 2,107,130 and 2,162,592. The defendants and one other firm are the only competitors of the petitioners and they reside in the Seventh Circuit. The possibility of further litigation and conflict of decision between the circuits is remote. This alone warrants review of this Court for the reasons pointed out in *Mackay Radio & Telegraph Co. v. Radio Corporation of America* (1939), 306 U. S. 86, 89; *Muncie Gear Works, Inc. v. Outboard Marine & Manufacturing Co.* (1942), 315 U. S. 759, 765-6; *Exhibit Supply Co. v. Ace Patents Corporation* (1942), 315 U. S. 126, 128; *Schriber-Schroth Co. v. Cleveland Trust Co.* (1938), 305 U. S. 47, 50.

2. Important questions of patent law have been decided in a manner in conflict with the decisions of this Court:

a. To sustain its charge of double patenting in 1,919,751 over 1,857,610, the opinion of the reviewing court was not in accord with this Court's decision in *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. Ed. 121. *Suffolk Co. v. Hayden*, 3 Wall. 315, 18 L. Ed. 76.

b. The reviewing court has treated findings of fact as conclusions of law contrary to this Court's decision in *Graver Tank & Manufacturing Company, Inc. v. Linde*

Air Products Company, 93 L. Ed. 493, 495. *Adamson v. Gilliland*, 242 U. S. 350, 353, 37 S. Ct. 169, 61 L. Ed. 356. *Federal Trade Commission v. Cement Institute*, 92 L. Ed. 806, 820.

c. The reviewing court in holding the elements of the devices in the patents in the suit are old to sustain the defenses of lack of novelty and invention is contrary to the decisions of this Court in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527.

d. The reviewing court's reversal on the ground that the devices in the suit are simple is contrary to this Court's decision in the *Diamond Rubber Co. v. Consolidated Rubber Tire*, *supra*.

e. The reviewing court's use as evidence of prior art a letters patent issued later than the patent in the suit is contrary to the decisions of this court in *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68; *Dubois v. Kirk*, 158 U. S. 58, 15 Sup. Ct. 729, 39 L. Ed. 895, which hold that for the purpose of anticipation a patent speaks not from the date of application but from the date of its issuance.

3. Important questions not heretofore settled by decisions of this Court.

One of these questions deals with the decisions of the Patent Office, particularly those of the Examiners who pass on the question of invention. The Court of Appeals (R. 393) states that the patent 2,020,912 met with rugged resistance from the examiner. It is further stated, (R. 393), that it is open to question whether the examiner finally gave his approval because of the merits of the invention or whether he succumbed to the persistency displayed by the patentee. Fundamentally, the patentee is granted the right, under the statute, to petition or apply with reasonable amendments thereto for a grant from the

federal government. It is presumed that the Examiner is qualified to pass upon that petition or application and that he based his decision on evidence before him, and there is ample evidence to sustain his conclusion.

Another question is the implied criticism of the trial courts adopting verbatim of the findings of fact and conclusions of law as proposed by the petitioner. The respondent had their remedy by Rule 52 (b) to move the trial court to amend those findings and conclusions but failed to do so.

4. The reviewing court has departed from the accepted course of judicial proceedings.

By treating the findings of fact as though they were conclusions of law and the conclusions of law as though they were findings of fact the reviewing court has departed from the accepted course of judicial proceedings and therefore has produced a result not otherwise obtainable.

Conclusion.

The judgment of the Court of Appeals has handed over to the respondents plaintiff's patents, which patents would have passed into public domain in some instances within a few months. Before the placing of the patents in the public domain, particularly in the hands of the respondents, this Court should examine the justice of the grants.

Respectfully submitted,

RICHMOND SCREW ANCHOR Co.,

By VICTOR E. LARUE,

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Attorneys for Petitioner.

IN THE

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..... TERM, A. D.

No.

RICHMOND SCREW ANCHOR CO., A CORPORATION,
Petitioner,
vs.

LAWRENCE H. UMBACH,
Respondents.

**BRIEF IN SUPPORT OF PETITION
 FOR WRIT OF CERTIORARI.**

The writ should issue to restore the patents to their owner, the Richmond Screw Anchor Co. of Brooklyn, New York, and not hand them over to public domain and particularly to the respondents doing business as the Superior Concrete Accessories at Chicago, Illinois.

The court should state whether there has been double patenting in 1,919,751 and whether the claims of the patents in 2,020,912, 2,107,130 and 2,162,592 are valid and whether the respondents have infringed these four named patents.

JUDGMENTS OF COURTS BELOW.

Judgment of District Court (Rec. 349).

Findings of Fact and Conclusions of Law (Rec. 344-348).

Judgment of Court of Appeals as Amended (Rec. 386).

JURISDICTION.

As noted in the petition, jurisdiction is invoked under Sec. 240 (a) of the Judicial Code 28 U. S. C. 347 (a).

STATEMENT OF FACTS.

The essential facts are set forth in the petition.

SPECIFICATION OF ERRORS TO BE URGED.

The Court of Appeals erred:

1. In holding that the patentee disclosed nothing in No. 1,919,751 that had not been fully disclosed in No. 1,857,610, and in reversing the judgment of the District Court with respect thereto.

2. In holding that a patentee, who seeks a patent upon a structure, but does not cover by claim certain novel features therein, may not apply, within one year from date of original application for a new patent covering disclosed but unclaimed novel features when the second application was made before the patent on the first application was issued.

3. In holding that one unidentified claim out of four named in the letters patent 2,020,912 is invalid, and in reversing the judgment of the District Court with respect thereto.

4. In holding a lack of invention by considering the facts, that application 2,020,912 met rugged resistance in the Patent Office and that it was an open question whether the Examiner finally gave his approval because of the merits of the invention or whether he succumbed to the persistency displayed by the patentee.

5. In holding that a letter patent issued subsequent to the patent in suit may be used as a prior publication to prove anticipation.

6. In holding the claim of 2,107,130 invalid and not infringed and in reversing the judgment of the District Court with respect thereto.

7. In holding the Kahn Patent 768,284 was a publication proving anticipation, said letter patent having been before the Examiner at the time patent No. 2,107,130 was granted.

8. In considering only a part of the testimony to prove infringement and thereby completely ignoring the admissions of the infringer made in the lower court.

9. In holding the claim of 2,162,592 invalid and in reversing the judgment of the District Court with respect thereto.

10. In holding that invention is not present when a change in shape secures a new result and makes for more effective operation.

11. In overruling the District Court by recognizing and employing secondary evidence, being drawings of the drawings of the patents in issue instead of the primary evidence consisting of the actual drawings of said patents.

12. In misinterpreting the legal effect of the failure of defendant Umbach to testify to the prior art, who was qualified as an inventor and expert in the art.

13. In misinterpreting the legal effect of the conflict in defendant's testimony as to the structures and operations of the patents in the suit, which evidence was contrary to their representations made to the trade during the existence of the license agreement from 1936 to 1945.

14. In treating findings of fact as conclusions of law and treating conclusions of law as findings of fact.

ARGUMENT.

Reasons Relied on for Allowance of Writ.

This Court should grant the writ prayed for because:

I. Possibility of Conflict Remote.

The District Court:

1. Held valid but not infringed Patent No. 1,857,610 (R. 347).
2. Held valid and infringed Patent No. 1,919,751 (R. 347).

The Court of Appeals considered Patents Nos. 1,857,610 and 1,919,751 together and held:

“We think the conclusion is inescapable that the patentee disclosed nothing in No. 1,919,751 that had not been fully disclosed in No. 1,857,610 and for that reason we must hold it invalid” (R. 392).

3. Held valid and infringed Patent No. 2,020,912. There are four claims in this patent* (Vol. 1 Exhibits 49). The Court of Appeals held:

“In our judgment, this patent does not disclose invention and we hold its claim invalid” (R. 396).

4. Held valid and infringed Patent No. 2,107,130 (R. 347). The patent has only one claim. The Court of Appeals held the claim invalid and not infringed (R. 400).
5. Held valid and infringed Patent No. 2,162,592 (R. 347). The patent has only one claim. The Court of Appeals held the claim invalid and not infringed (R. 400).
6. Held valid and not infringed Patent No. 2,222,339. The Court of Appeals held it valid in its original opinion

of January 18, 1949, but in its amended opinion of March 15, 1949, held it invalid (R. 402).

The courts have disagreed upon the validity and infringement of at least four of the five patents in the suit. The defendants are the only competitors of the petitioner and they reside in the Seventh Circuit. The possibility of further litigation and conflict of decision between the circuits is remote. The judgment of the Court of Appeals is likely to prevent any further inquiry into the validity and infringement of the patents.

In *Muncie Gear Works, Inc. v. Outboard Marine and Manufacturing Co.* (1942) 315 U. S. 759, 765-6, 86 L. ed. 1171,

"While there was no conflict of decision with respect to these claims we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions is unlikely.

314 U. S. 594, Ante 479, 62 S. Ct. 100.

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47, 86 L. ed. 34, 59 S. Ct. 8."

Jurisdiction.

Exhibit Supply Co. v. Ace Patents Corporation (1942) 315 U. S. 126, 128, 86 L. ed. 736,

"We granted certiorari, 314 U. S. 705 ante 563, 62 S. Ct. 175, on a petition which challenged only the decree of infringement below on the ground that it enlarged the scope of the patent as defined by the claim, by resort to the doctrine of equivalents and that Nelson, the patentee by the amendment of his claim in the Patent Office had surrendered claim 4 so far as would otherwise read upon the alleged infringing device."

Mackay Radio & Teleg. Co. v. Radio Corp. of America
(1939) 306 U. S. 86, 89, 83 L. ed. 506,

"We granted certiorari because of the nature and importance of the case, on a petition which urged as grounds for its allowance that validity and infringement of the Carter patent were in doubt and that, as petitioner is the only competitor of respondent in the business of world wide public radio communication, further litigation resulting in conflict of decisions among circuits was improbable."

Schriber-Schroth Co. v. Cleveland Trust Co. (1939)
305 U. S. 47, 50,

"Petition for certiorari raising the question, among others, whether the Court of Appeals had erred in holding patentable a combination including one element not described in the original application for the Gulick patent and later added to it by amendment, and not described at all in the Maynard patent was at first denied, there being no conflict of decision, 303 U. S. 587, 82 L. Ed. 1548, 58 S. Ct. 1052, 1053. We later granted certiorari in 304 U. S. 587 * * * on a petition for rehearing showing notwithstanding the doubtful validity of the patents. Litigations elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the Sixth Circuit.

294 U. S. 464, 79 L. ed. 997, 55 S. Ct. 449.

Publex Theatres v. American Tri. Ergon Corp.,
294 U. S. 477, 79 L. ed. 1005, 55 S. Ct. 455."

II. The Court of Appeals Had Decided Questions Concerning Patents Probably in Conflict With the Decisions of This Court.

The court of appeals in declaring the patents invalid and not infringed has applied federal questions which are in conflict with the Court's cases and should the same application be made to other causes the damage of such application sanctioned by the court below, would be great.

III. The Court of Appeals Did Not Follow Rule 52 (a) of Federal Rules.

The Court of Appeals did not apply Rule 52(a) of the Federal Rules of Civil Procedure to instant case. The rule provides in part:

“Findings of Fact shall not be set aside unless clearly erroneous and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.”

The trial court heard testimony of petitioner's expert witnesses to the detailed elements of each patent in the suit during the presentation of the plaintiff's case, as to their structure and operation.

The respondents offered no testimony in connection with the book of prior art letters patent and publications to prove anticipation.

It was this lack of positive evidence on the part of the respondents to maintain their plea of lack of novelty that enables the law to clarify the issue.

In *Graver Tank & Manufacturing Company, Inc. v. Linde Air Products Company*, 93 L. ed. 493, 495,

“Rule 52(a) of the Federal Rules of Civil Procedure provides in part: ‘Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.’

“To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. This trial occupied some three weeks, during which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual demonstrations of welding as taught by the patent and of the welding accused of infringing

it, and of various stages of the prior art. He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues."

In *Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. (2) 628, 630:

"On both questions—the question of validity and the question of infringement—the trial judge, who personally heard the evidence and personally inspected the accused tractors, decided against appellant. His findings, unless clearly wrong, should not be disturbed. *Adamson v. Gilliland*, 242 U. S. 350, 353, 37 S. Ct. 169, 61 L. ed. 356; *Diamond Patent Co. v. Webster Bros.* (C. C. A. 9) 249 F. 155, 158; *Central California Canneries Co. v. Dunkley Co.* (C. C. A. 9) 247 F. 790, 794."

The expertness of the patent office examiner should be considered in dealing with the questions of novelty and invention. His decision should not be lightly set aside and only on manifest error. The federal courts have always sustained the decisions of the various departments of the federal government and only reversed them on manifest error.

In *Federal Trade Commission v. Cement Institute*, 92 L. ed. 806, 820, it is stated that Congress recognized the value of expertness derived from long experience.

"For Congress acted upon a Committee report stating: 'It is manifestly desirable that the terms of the commissioners shall be long enough to give them an opportunity to acquire the expertness in dealing with these special questions concerning industry that comes from experience.'"

The Court of Appeals to vitiate the substance of the findings of fact advance the contentions (1) that the trial court adopted verbatim the petitioner's finding of fact (2)

the elements in the patents are old and (3) the trial court's finding that the defendants could not name any patent that shows all the structures and operation of the plaintiff's patent has little, if any, value in support of the court's conclusion of validity.

The charge that the trial court adopted verbatim the petitioner's findings of fact stands alone and is unexplained. The question is whether this mere charge is such as would enable the reviewing court to set aside the findings of fact. It is presumed that the work of the attorneys as officers of the court and the work of the court even though they see eye to eye is in accordance with the law.

The Court of Appeals states the elements are old. There was no such finding of fact made by the lower court. There was no motion to amend the finding of fact by the respondents in accordance with Rule 52 (b) of the Federal Rules of Civil Procedure.

"Rule 52.

Findings by the Court.

b. Amendment. Upon motion of a party made not later than 10 days after entry of judgment the court may amend the judgment accordingly. The motion may be made with a motion for a new trial pursuant to Rule 59. When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment."

By assuming that all the elements of the patents in the suit are old the question is whether this fact that the elements are old would sustain the defense of lack of novelty.

In *Levin v. Coe*, 132 F. 2d, 589, 596:

"It is also settled in the law of patents that the fact

that all of the elements entering into a combination are old does not necessarily negative the existence of invention. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 1911, 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527; *Iron Fireman Mfg. Co. v. Industrial Engineering Corp.*, 7 Cir. 1937, 89 F. 2d 904. Such a combination may be patentable invention if it produces a new result, or an old result in a new or more efficient way. *Independent Oil Well Cementing Co. v. Halliburton*, 10 Cir., 1932, 54 F. 2d 900, certiorari denied, 1932, 286 U. S. 544, 52 S. Ct. 496, 76 L. Ed. 1281; *N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.*, 1928, 25 F. 2d 659, certiorari denied, 1932, 287 U. S. 617, 53 S. Ct. 18, 77 L. Ed. 536; see Walker on Patents (Deller's ed. 1937) 147-149. The fact that the combination later appears to be a simple one does not necessarily negative the presence of a high degree of inventive genius. *Loom Company v. Higgins*, 1881, 105 U. S. 580, 26 L. Ed. 1177; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, *supra*. We recognized these principles in *Electrons, Inc. v. Coe*, 1938, 69 App. D. C. 181, 99 F. 2d 414."

The one finding of fact mentioned in the opinion, (R. 388) that the defendants could not name any patent that shows all the structures or operations of the plaintiff's patent was, in identical form, used in the *Dixie-Vortex Co. v. Paper Container Mfg. Co.*, 130 F. 2d 569 (C. C. A.), wherein Major, Chief Judge, sustained the finding of validity by the lower court.

Patents No. 1,857,610 and No. 1,919,751.

The Court of Appeals disagrees with the trial court which held there was no double patenting, that is, "the second patent in suit 'discloses invention over Schenck Patent No. 1,857,610' " (R. 345). The basis for the reversal is that the patentee disclosed nothing in No. 1,919,751 that had not been fully disclosed in No. 1,857,610 (R. 392).

The applications for these patents were co-pending in the Patent Office and were by the same inventor. There are two structures, the tie rod and the wedge. The wedge was disclosed in No. 1,857,610 where it was mentioned in name only "bottom-heavy wedge" in claim of 1,857,610. The claims are placed side by side in the appendix. The division was made in the patent office as indicated by the letters patent of No. 1,919,751.

"This application is a division of my earlier application for form ties filed May 1, 1931 and patented May 10, 1932, No. 1,857,610" (Vol. 1, Exhibits 25).

During the trial No. 1,857,610 was dismissed out of the suit save the disclosures on the wedge as there was no infringement of the tie rod.

The rule laid down in the opinion would preclude any division whatsoever in the Patent Office. The petitioner urges that it is a comparison of the claims which is to determine this question of double patenting. The claims are in the appendix.

In *Shipp v. Scott Tp., Montgomery County, Ind.*, 54 F. (2) 1019, 1021 (C. C. A. 7):

"The question involving their consideration may be stated thus: May A, who seeks a patent upon a certain structure and discloses, but does not cover by claim, certain novel features therein, apply, within two years from the reduction of his invention to practice, for a new patent covering the disclosed but unclaimed novel features in the earlier application, when it appears that the second application was made after the patent on the first application had issued?"

page 1022:

"Getting back to the original proposition that waiver and dedication are both ordinarily questions of fact, it becomes necessary for the court to place applicant's act in failing to claim all of his discovery against his

other act of filing another application, within the time permitted by statute, wherein he made claim to the disclosed but uncovered features of his first application. If no other fact appears bearing upon the issue of waiver, it would seem, upon this showing, that a finding in the inventor's favor would be unavoidable."

In *Ruben, et al. v. Ariston Laboratories, Inc.*, 40 F. Supp. 551, 570 (Barnes, Ill.):

"The applications were filed within three months of each other, were co-pending, and were examined and passed by the same examiner in the Patent Office. The first patent to issue was issued on an application which was a continuation in part of the application on which the second patent issued. The second patent issued four weeks after the first. Each of the claims of the second patent differs sufficiently from each of the claims of the first to negative the idea of double patenting. *Pyle Nat. Co. v. Lewin*, 7 Cir., 92 F. 2d 628; *Traitel Marble Co. v. Hungerford Co.*, 2 Cir., 22 F. 2d 259; *Gibbs v. Triumph Trap Co.*, 2 Circ. 26 F. 2d 312; *Lewis Invisible Stitch Machine Co. v. Popper*, D. C. 5 F. Supp. 859."

In *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259, 260:

"The two applications were copending, and it is a matter of indifference which of the patents issued first, provided that the claims are for separate inventions. This was held after elaborate discussion in *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. Ed. 121, and had been already decided in *Suffolk Co. v. Hayden*, 3 Wall. 315, 18 L. Ed. 76. It has often been decided in this court (*Electrical Accumulator Co. v. Brush Electric Co.*, 52 F. 130; *Thomson, etc. Co. v. Elmira, etc. Co.*, 71 F. 396; *Kinnear Mfg. Co. v. Wilson*, 142 F. 970; *Victor, etc. Co. v. American, etc. Co.*, 145 F. 350), and is the law elsewhere (*Thomson, etc. Co. v. Ohio Brass Co.*, 80 F. 712 (C. C. A. 6); *Century, etc. Co. v. Westinghouse, etc. Co.*, 191 F. 350 (C. C. A. 8)).

The issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference."

On page 262:

"The defense is good only when the claims are the same, and the discussion in *Miller v. Eagle Mfg. Co.*, *supra*, was really of this point. As we have held that the original claims and the claims in suit are not the same, the defense fails. It is, indeed, quite true that Calkins gets a protection for more than 17 years for the continuous edged strip. He got it during the existence of the original generic claims, and he gets it from the claims in suit. Yet it is never an objection to an improvement patent that an earlier generic patent has covered the same structure, and each is valid, though taken out by a single inventor. *O'Reilly v. Morse*, 15 How. 62, 122, 133, 134, 14 L. Ed. 601. This is precisely the same situation, except that, because the applications were copending, it is not necessary that the improvement should be an invention over the matters disclosed in the other application. In view of the fact that the date of issue of an application is beyond the control of the applicant, the chance of so extending the monopoly is disregarded, and it makes no difference which of the applications issues first. *Thomson-Houston Co. v. Ohio Brass Co.* (C. C. A.), 80 F. 712, 726, 727."

Patent No. 2,020,912.

The Court of Appeals held this patent does not disclose invention (R. 396). The court stresses the fact that the application met with rugged resistance in the patent office. The main issue concerned the importance of an integral ring which was used as a stop to space the form boards used in producing a concrete wall. This stop in the patentee's form tie was strong while other stops in the prior art were weak. The court has overlooked the fact that this

stop insured the breakoff within the wall, and that it was easy to twist and snap. It was accepted in the trade, numbered in millions, proving itself to be the nucleus of the concrete accessories business (Pl. Ex. 65, Vol. 1, Ex. 205). The defendants' patent, Umbach 1,907,618, was one of the patents which was before the Examiner and which was found by the Examiner not to anticipate patent in suit. (Vol. 1, Ex. 60-61 File Wrapper.) (A copy of the Claim 3 is found in the appendix.)

The rugged resistance which the application met in the patent office should prove and not disprove invention. This is a new question which has never been decided by this court. It is akin to the presumption of invention which accompanies the issuance of the patent.

The Court of Appeals states the Pinaud patent 2,095,814 appears to be the most pertinent of prior art patents and was not cited by the Patent Office (R. 394). The question is whether it is to be considered as a prior art publication. It was copending in the Patent Office with the patent in the suit. It was issued later than the patent in the suit as evidenced by its higher patent number.

In *Park-In Theatres, Inc. v. Rogers, et al.*, 130 F. 2d 745, 747:

"The issuance of the patent is presumptive evidence of invention and patentability. The presumption is so strong that in the event of a reasonable doubt as to patentability or invention that doubt must be resolved in favor of the validity of the patent. *Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171, 57 S. Ct. 675, 81 L. Ed. 983."

In *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 F. 2d 91, 94:

"Both patents were regularly issued. Hence both patents and all claims thereof were presumptively valid. *Radio Corporation of America v. Radio En-*

gineering Laboratories, 293 U. S. 1, 7-10, 54 S. Ct. 752, 78 L. Ed. 1453; *Reinharts v. Caterpillar Tractor Co.*, 9 Circ., 85 F. 2d 626, 630.

In *Perfection Disappearing Bed Co. Inc. et al. v. Murphy Wall Bed Co. et al.*, 266 F. (C. C. A. 9) 698, 700:

"For the purpose of anticipation, a patent speaks, not from the date of the application, but from the date of its issuance. *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68; *DuBois v. Kirk*, 158 U. S. 58, 15 Sup. Ct. 729, 39 L. Ed. 895; *American Roll Paper Co. v. Weston* (C. C.), 45 Fed. 686, 689; *Anderson v. Collins*, 122 Fed. 451, 58 C. C. A. 669; *General Electric Co. v. Allis-Chalmers Co.* (C. C.), 190 Fed. 165, 170; *Turner Brass Works v. Appliance Mfg. Co.* (C. C.), 203 Fed. 1001.

See also Walker on Patents, Vol. 1, p. 136, Sec. 26, Prior Art.

Patent No. 2,107,130.

The court held this patent to be invalid but said it came closer to approaching a patentable status than any of the patents in the suit, that it was subject to stress in the patent office and cited the Kahn patent in anticipation (R. 398).

The Kahn patent 768,284 was before the Examiner (Vol. 1 of Exhibit 90).

In 3 Walker on Patents (1937 Ed.) 2010, Sec. 701, it states:

"The presumption of validity is strengthened by the circumstance that the alleged anticipating patent was considered by the Patent Office in connection with the application for the patent in suit. (*Hale & Kilburn Mfg. Co. v. Oneonta, etc. Ry. Co.*, 129 Fed. 598, 600, C. C. N. Y. (1904), *Beckwith v. Malleable Iron Range Co.*, 175 Fed. 1001, 1012, C. C. Wis. (1910); *New Jersey Wire Cloth Co. v. Buffalo Expanded Metal Co.*, 131 Fed. 265, 268, C. C. N. Y. (1904); *J. A. Mohr & Son*

v. Alliance Securities Co., 14 F. (2d) 799, C. C. A. 9 (1926); *Elinson Freeman Co. v. Int. Folding Paper Box Co.*, 21 F. (2d) 701, 703, D. C. N. Y. (1927); *Nordberg Mfg. Co. v. Woolery Machine Co.*, 79 F. (2d) 685, 687, C. C. A. 7 (1935); *Gulf Smokeless Coal Co. v. Sutton Steele & Steele*, 35 F. (2d) 433, 437, C. C. A. 4 (1929), cert. den. 280 U. S. 609, 74 L. Ed. 652 (1930).''

This patent No. 2,107,130, was the only patent in the suit which the reviewing court held both invalid and not infringed. There is only one claim which is in the appendix. The lack of infringement was based upon petitioner's testimony (R. 234). Snyder, the petitioner's witness, did not see the disk or washer, that is to say, the center member of the three elements. It was hidden between the two outer members. It was Umbach, one of the defendants, testifying for the defense, who later supplied the information concerning the hidden disk or washer.

Thus the infringing device differs only with the patent in suit in that it has enlarged two outer members and they were fused on the rod. All other features are the same. The purpose is the same in each instance, that is, to act as a barrier about which the water must flow to pass along the length of the rod.

In *General Electric Co. v. Leviton Mfg. Co.* (D. C. E. N. Y.), 31 F. S. 580, 45 U. S. P. Q. 214, it is stated:

"In defendant's device, ears, instead of being physically attached to outer ends of cross-bar are formed of separate pieces of metal which surround ends of cross-bar and are clamped in place, ears perform same function in same way as ears of patent in suit; defendant does not escape infringement by making its ears in separate pieces of metal and inserting them in rest of device; infringement cannot be avoided by making ears in two parts instead of one part as in patent in suit; test is, do two parts of defendant's device function same as one part of patent in suit; prior art does not restrict 'integral' as found in claim."

Patent No. 2,162,592.

The Court of Appeals declared the single claim of patent to be invalid saying that it was an improvement which resided well within the area of mechanical skill. The single claim is in the appendix. The opinion quotes features from a prior art patent, the Whitescarver, that by making the cone "corrugated, the walls of the recesses formed thereby are correspondingly corrugated to more readily anchor the cement filler in place". The fallacy in the reasoning is assuming the corrugated cone No. 23 of the Whitescarver patent is the same as the projections 4 in the patents in the suit. This prior art patent was before the Examiner (Vol. 1, Exhibits 107). The attorney for the patentee, as disclosed by the file wrapper, presented a brief to point out the dissimilarity between the device in Whitescarver patent and the device in the application.

"It is, of course, well established that when a change in shape secures a new result and makes for more effective operation, invention is present. *Hawkinson et al. v. Skogmo-Gamble, Inc. et al.*, 35 Pat. Q. 174; *Ex Parte Johnson*, 32 Pat. Q. 83; the 'slots' instead of 'slits' case, *Ex Parte Ferguson*, 31 Pat. Q. 431.

"In *Ex Parte Crowley*, 30 Pat. Q. 284, the use of a tapered instead of a cylindrical coil spring was held patentable since such a change in shape (despite the fact that tapered coil springs are old in the spring art) produced improved results."

Failure to Produce Evidence.

The prior art patents introduced by the defendants to prove the lack of novelty in this and the other patents in the suit consisted of over one hundred letters patent (Def. Ex. 12). With the exception of introducing a drawing of some of the drawings of these prior art patents to which the petitioner objected as secondary evidence (R. 316-318),

the book of patents, the primary evidence, was not used during the trial. Umbach, as an inventor, who was familiar with the prior art, testified on the question of invention but made no mention of these letters patent. Obviously, the trial court did not believe him on the questions of lack of invention, as he, with the other defendants, had been licensees of the Richmond Screw Anchor Co. of Brooklyn, New York, for eight years and as such licensees manufactured and sold the patented articles. His testimony was in conflict with the statements in his advertising concerning these patents. On the question of lack of novelty, the failure of Umbach to explain the prior art as it appears in the letters patent raises the question whether his failure to testify as to the prior art supports the inference that the tenor of such evidence would be unfavorable to the defendants' plea of lack of novelty.

It is contended that this failure to testify as to the prior art supports the inference that the tenor of such evidence would be unfavorable to defendant's plea of lack of novelty. In 2 Wigmore (3rd Ed.) 162, Sec. 285:

"The consciousness indicated by conduct may be, not an indefinite one affecting the weakness of the cause at large, but a specific one concerning the defects of a *particular element* in the cause. The failure to bring before the tribunal some circumstance, document, or witness, when either the party himself or his opponent claims that the facts would thereby be elucidated, serves to indicate, as the most natural inference, that the party fears to do so, and this fear is some evidence that the circumstance or document or witness, if brought, would have exposed facts unfavorable to the party. These inferences, to be sure, cannot fairly be made except upon certain conditions; and they are also open always to explanation by circumstances which make some other hypothesis a more natural one than the party's fear of exposure. But

the propriety of such an inference in general is not doubted.

"The nonproduction of evidence that would naturally have been produced by an honest and therefore fearless claimant permits the inference that its *tenor is unfavorable to the party's cause*. Ever since the cause of Chimneysweeper's Jewel, this has been a recognized principle."

IV. The Court of Appeals Has Departed from the Accepted Course of Judicial Proceedings.

Upon the questions of law, the reviewing court may, without restraint, exercise its own judgment.

Upon the findings of fact, supported by the record, the views of the trial court are conclusive.

In the instant case the reviewing court has reversed the process and considered findings of fact as conclusions of law.

It adopted as a conclusion of law that all the elements of all the patents are old, that the elements are only four in number and that each element is like its counterpart in another prior art publication or letters patent.

It treated as a finding of fact, that the defendants could not name any patent that shows all the structures and operations of plaintiff's patent as a conclusion of law.

It forecloses the Patent Office from issuing a second patent upon the same disclosure within the time prescribed by statute.

It considered as evidence of the lack of invention the fact that the application met rugged resistance in the Patent Office and the additional fact that it is an open question whether the Examiner finally gave his approval

because of the merits of invention or whether he succumbed to the persistency displayed by the patentee.

It considered as a part of the prior art a publication in the form of a letters patent which had been issued subsequent to the patent in the suit.

It has not considered the admissions and omissions in the testimony of the defendants and that the lower court had the opportunity to judge the defendants' witness.

It has not given any consideration whatsoever to the fact that defendants, as licensees, had used these patented devices for eight years instead of their own and other patents which they now claim anticipates petitioner's patents.

It has treated the question of validity—the lack of novelty and the lack of invention—as questions of law.

Without exception the Court of Appeals has given to the respondents and to the public domain the patents in suit, and by the simple expedient of proclaiming all the elements old has foreclosed the Patent Office from issuing a patent which shows invention in the use of these elements. Such a test at once lays a foundation for declaring all other such patents invalid. Thus by mixing conclusions of law and findings of fact, there is less review given than the law demands. This course of action is not in accordance with the accepted and usual course of judicial proceedings and presents an important question in which the public has an interest.

The Writ should issue.

Respectfully submitted,

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APPENDIX.

Claims 1 and 2 of Schenck Patent No. 1,857,610 which are as follows:

"1. A form tie having a stop welded thereto against which a form may rest, and means for holding a form against the stop, the weld making the tie brittle at the point of the weld without decreasing substantially the tensile strength of the form tie, the weld making the tie easily breakable when bent at the weld.

"2. The substance of claim 1 characterized by a holding means composed of a bottom-heavy wedge."

Claims 1 and 2 of Schenck Patent No. 1,919,751 are as follows:

"1. A bottom-heavy wedge for form ties having spaced walls defining a slot between them, said walls having outer parallel surfaces, which diverge from the inner surfaces of said walls to the top of the wedge, a loop at the bottom of the walls connecting said walls and enlarging the lower end of the slot so that the enlarged end of a form tie may be passed through the loop and the weight of said loop will tend to hold the wedge in a vertically disposed position.

"2. A bottom heavy wedge for form ties having spaced parallel walls defining a slot between them, said walls having outer parallel surfaces diverging from the inner surfaces of said walls to the top of the wedge, a loop at the bottom of the walls connecting said walls and enlarging the lower end of the slot so that the end of a form tie may be passed through the

loop and the weight of the loop will tend to hold the wedge in a vertically disposed position, the loop extending out diagonally from the walls of the wedge."

Claim 3 of Patent No. 2,020,912:

"3. A form tie consisting of a rod having weakened break-off points, the rod being provided with end portions extending from said break-off points adapted to be broken off by twisting movement about the longitudinal axis of the rod, stops on said end portions consisting of parts formed by enlargement of the diameter of the body of the rod without weakening said rod, and washers adapted to be held against said stops, the end portions of the rod being freely movable within the washers while said end portions are being twisted."

Claim of Patent No. 2,107,130:

"A rod for incorporation in a concrete structure, having a body portion of substantially uniform diameter extending from one side of the concrete structure to the other and provided with at least one disk tightly positioned on it and extending radially of it whereby said disk will be completely embedded in and surrounded by the concrete structure and will interrupt the formation of voids in concrete around the rod, which voids normally follow the body of the rod, and means for holding said disk in position on the rod comprising an annular raised rib integrally formed on the rod on each side of the disk whereby the disk is tightly gripped between said annular ribs and any space between the disk and rod is sealed and leakage between the disk and body of the rod is thereby prevented by said ribs."

Claim of Patent No. 2,162,592:

"A form tie comprising a rod upon which a form board spacing disk is located, said disk being of

shallow concavo-convex formation and being composed of sheet metal having a conical concrete-contacting face provided with a plurality of spaced projections pressed out of the body of the disk, and formed at its larger end with a radially projecting flat marginal flange, the opposite or smaller end of the conical disk having a central aperture through which the rod extends, said aperture being surrounded by metal forced from the aperture and directed toward the concave side of the disk to form a boss-like flange fitting around the rod, the projections on the disk being wholly located between the marginal flange on the disk and the aperture and having closed ends spaced from the said flange and aperture respectively, whereby a plurality of spaced recesses or pockets free from communication with either the inner or outer ends of the depression formed in the wall will be produced in said depression for the reception of pointing concrete."

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No. 745

RICHMOND SCREW ANCHOR CO., INC.,
a Corporation,

Petitioner,

vs.

LAWRENCE H. UMBACH, Et AL,

Respondents.

**BRIEF FOR RESPONDENTS ON PETITION FOR
WRIT OF CERTIORARI**

✓
mc **FRED GERLACH,**
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INDEX

Foreword	1
Minor character of patents in suit	1
No question of general importance, or novel point of law involved	2
Argumentative findings of the District Court	3
Alleged absence of fabricators in other circuits not in record of case	3
Divergence between Court of Appeals and District Court	3, 4
Comments on "Matter Involved" and "Questions Pre- sented" stated by petitioner	5
Patents not included	5
Patent No. 1,957,610 includes claim for wedge	5
Court of Appeals held invalid all claims of Patent No. 2,020,912	6
Court of Appeals did not rule on validity of Patent No. 2,222,339	6, 7
Pinaud Patent relied on for prior invention	7
File Wrapper of Patent No. 2,107,130 not referred to by petitioner	7
Alleged secondary evidence	8
Court of Appeals explained patents, prior art and grounds for its conclusions	8
The District Court's findings discussed	8, 9
Argument	10
Old subject matter in patents in suit	10, 11
Patent No. 1,857,610	10
Patent No. 1,919,751	11
Patent No. 2,020,912	11
Patent No. 2,107,130	11

	PAGE
Patent No. 2,162,592	11
Patent No. 2,222,339	11
Lack of invention and disclosure in Patent No. 1,857,- 610	12
Double patenting and invalidity of Patent No. 1,919,751 resulting from Claim 2 for same wedge in Patent No. 1,857,610	13
Anticipation of and lack of disclosure in Patent No. 2,020,912	15
File wrapper estoppel against anticipation of Patent No. 2,107,130	18
Lack of invention in Patent No. 2,162,592	19
Suit dismissed as to Patent No. 2,222,339 to eliminate finding of validity after non-infringement was ad- judged	20
Conclusion	21

TABLE OF AUTHORITIES.

Electric Fittings Corp. et al v. Thomas & Betts Co., 307 U. S. 241-242	21
Florsheim v. Schilling, 137 U. S. 64, 72	4
Hartford Empire Co. v. Shawkee Mfg. Co., 147 F. 2d 532, 555 (C. A. 3)	9
Hubbell v. United States, 179 U. S. 77, 80	19
Knapp v. Morse, 150 U. S. 221, 224	19
Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545, 549	11
Milburn Co. v. Davis Bournonville Co., 270 U. S. 390	7
Miller v. Eagle, 151 U. S. 186, 198	4, 14

IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1948.

No. 745

RICHMOND SCREW ANCHOR CO., INC.,
a Corporation,

Petitioner,

VS.

LAWRENCE H. UMBACH, Et Al.,

Respondents.

**BRIEF FOR RESPONDENTS ON PETITION FOR
WRIT OF CERTIORARI**

*To the Honorable The Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

FOREWORD.

The patents in suit involve mere details in ties for use in molds for concrete walls, in an extremely old art, as shown by the patents in Exhibit Book Vol. II. and the statement of the Court of Appeals (R. 387):

“There are many prior art patents which disclose, as do the patents in suit, ties extending through the form walls and the concrete, spacers for holding apart the sides of the form for the concrete, devices for holding the walls on the ties during the pouring of the concrete and means to break off the projecting ends of the ties after the concrete has set.”

The detail or minor character of the alleged improvements in the patents in suit is apparent.

The first patent in suit (No. 1,857,610) is for pieces of wire welded on the rod to serve as spacers, many different forms of spacers being old, including elements welded on the tie.

The second patent in suit (No. 1,919,751) is for a detail in the wedge for holding the form on the tie, many forms of wedges being old.

The third patent in suit (No. 2,020,130) is for upsets on the tie serving as spacers and break-offs for the ends of the rods, both of which were old in several prior patents.

The fourth patent in suit (No. 2,017,130) is for a tie rod with a washer or disk confined between annular ribs on the tie, which the Court of Appeals held anticipated and not infringed.

The fifth patent (No. 2,162,592) is for a detail in the shape of the stop washer on the tie rod, contours for the same purpose being old in the art.

The sixth patent (No. 2,222,339) is for details on the tie, and was held not infringed in accord with the finding submitted by petitioner.

This minor character of the alleged novelty in the patents is clearly pointed out by the Court of Appeals. With respect to Patent No. 1,857,610, that court said:

“Either with or without any prior art, the process of attaching two metals by welding is so old and well known as to preclude the thought that its use could constitute invention.”

With respect to Patent No. 2,162,592, the Court of Appeals said (R. 402):

“in fact, without the aid of any prior art we would hesitate to dignify the disclosure with a patentable status.”

No question of general importance is involved. No important or novel question of law on the validity of the patents in suit is involved. Nowhere does the petition

point out how or why the opinion of the Court of Appeals in holding the patents in suit invalid, is not in accord with the precedents established in this court. No question of law is involved which has not heretofore been settled by the decisions of this court. The Court of Appeals applied, on most issues, decisions of this court in support of its findings.

The District Court relied upon argumentative findings adopted verbatim as submitted by petitioner, without an opinion or enlightening discussion of the issues. The Court of Appeals rendered an opinion with a complete discussion of the facts and law, and the comment that the argumentative findings of the District Court have "little, if any, value in support of the Court's conclusion of validity."

The petitioner, as a reason for allowance of the writ, urges that defendants and one other concern are the only competitors of the petitioner and they reside in the Seventh Circuit and that the possibility of further litigation and conflict of decision between the circuits is remote.

There is no evidence in the record to show that there are no competitors or other fabricators or sellers of tie rods for concrete forms throughout the United States. As a matter of fact there are large producers of tie rods for concrete wall forms, of which petitioner is aware, located in Miamisburg, Ohio, Birmingham, Ala., and Camden, N. J. The fact asserted by petitioner is not in the case and the authorities cited by petitioner are not applicable here.

The main divergence between the District Court and the Court of Appeals on the questions of anticipation and lack of invention arises from the erroneous principle which the District Court followed that anticipation or want of invention must be shown in a *single* prior art patent or device as set forth in the argumentative findings submitted

by petitioner in connection with each of the patents in suit.

The Court of Appeals said (R. 388):

“As we understand, plaintiff does not dispute but that the elements relied upon as patentable invention are found in the prior art, but its main contention is that the patents in suit are not anticipated because the improvements disclosed in connection with other elements claimed are not all shown in a single prior art patent.”

The Court of Appeals followed the rule of this court set forth in *Florsheim v. Schilling*, 137 U. S. 64, 72; 34 Law. Ed. 574, 578, to the effect that the entire prior art is to be considered, and held:

“Certainly it cannot be doubted that the entire prior art may be looked to, and the mere fact that some of the elements of a combination claim are found in one prior art patent and other elements in another does not render such art impotent as a guide for ascertaining novelty.”

The divergence between the District Court and the Court of Appeals on the issue of double patenting (Patent No. 1,919,751) arises from the failure of the District Court to follow the rule established by this court in *Miller v. Eagle*, 151 U. S. 186, 198, that a second patent to be valid must be for a separate invention distinctively different and independent from that covered by the first patent and must not consist of a mere distinction of the breadth or scope of the claims. It cannot cover matter inseparably involved in the matter embraced in the first patent. The Court of Appeals followed the decisions of this court and the District Court cited no authority on this point.

The reasons for the allowance of the writ set forth in pages 12 to 14 of the petition are not, we submit, of the character specified in rule 38, paragraph 5, of the rules of this court.

**Comments on Petitioner's Statement of "Matter Involved"
(Pages 4 and 5) and "Questions Presented"
(Pages 10 and 11).**

Validity of patents in suit No. 1,857,610, No. 2,162,592 and No. 2,222,339 is not included in petitioner's statement (pages 4 and 5) of the matters involved.

Paragraph 2 on page 4 of the petition with respect to Patent No. 1,919,751 does not indicate that the identical wedge is covered by Claim 2 of Patent No. 1,857,610 and that the claims of Patent No. 1,919,751 resulted in the patentee obtaining two patents for the same device, in violation of the rule against double patenting. The description and drawings in both patents with respect to the wedge and rod are identical, and Claim 2 of Patent No. 1,857,610 describes the wedge as "bottom heavy" while Claims 1 and 2 of Patent No. 1,919,751 include the same wedge with language referring to the same attributes of the wedge of the first patent, which make the wedge bottom heavy. The effect of the two patents for the same wedge was to prolong the monopoly of the same wedge beyond a single term of seventeen years and under the decisions of this court amounts to double patenting.

We challenge the accuracy or correctness of questions 1 and 2 on page 10 of the petition which impliedly involve "double patenting." The patentee procured Patent No. 1,857,610 with Claim 2 for a tie rod and a certain wedge, and procured a second patent, No. 1,919,751, for the identical wedge covered by Claim 2 of the first patent.

Petitioner's statement that the first patent did not claim the wedge is incorrect. The patentee illustrated, described and claimed in the second patent the identical wedge referred to in Claim 2 of Patent No. 1,857,610. A few days before the issue of the first patent the patentee filed the application for the second patent, No. 1,919,751, with an identical description and drawing of the wedge

and tie on which Claim 2 of the first patent was predicated, and claimed the same wedge with more detailed language as to the essential attributes of the "bottom heavy" wedge in Claim 2 of the first patent.

Nowhere in the petition is it asserted that the second patent is actually for a separate and distinct invention, which is the determinative point on "double patenting."

Under the title "Matter Involved" on page 5, (2), the petition states:

"The Court of Appeals held one unidentified claim out of the four claims [Patent No. 2,020,912] invalid."

This *misinterprets* the decision of the Court of Appeals, which held the entire patent invalid. That court (R. 392) said:

"It has four claims, all held to have been infringed. Claim 3 is illustrative."

The sentence quoted by petitioner (page 2, par. 3) refers to Claim 3, which was treated as illustrative of all four claims. The Court of Appeals said (R. 396):

"This patent does not disclose invention * * *."

Obviously the court held that Claim 3 and all of the other claims of which it was illustrative, were invalid. The judgment (R. 404) of the Court of Appeals reversed the entire judgment in the District Court which held Claims 1 to 4 valid. The opinion in its entirety and the judgment of the Court of Appeals clearly show all of the claims of Patent No. 2,020,912 were held invalid.

The petition (p. 3, par. 6) misstates the holdings of the District Court and that of the Court of Appeals in connection with patent in suit, No. 2,222,339. It states, the Court of Appeals:

“* * * in its amended opinion of March 15, 1949, held it invalid.”

The Court of Appeals made no holding on validity. It reversed the District Court because there was no dismissal of the complaint as to that patent after the charge of infringement was abandoned.

Questions 5 and 6 (p. 10) refer to the use of the Pinaud patent (Ex. Book II. 608) as a prior publication. The publication is not an issue. By reason of its earlier filing date, it establishes lack of novelty in Patent No. 2,020,912 under *Milburn Co. v. Davis Bournonville Co.*, 270 U. S. 390.

Questions 7 and 8 on page 10 of the petition, relating to Patent No. 2,107,130, are inaccurate and incomplete. They fail to indicate that the patentee, as shown by the file history of Patent No. 2,107,130, cancelled broad claims in view of the rejections of the Patent Office and ultimately limited the claim to the specific construction illustrated and described as explained by the Court of Appeals (R. 397) to induce allowance and thereby became estopped from asserting for the limited claim the scope of the rejected claims, as set forth in the opinion of the Court of Appeals (R. 400) where it said that the patentee—

“* * * is estopped from asserting infringement of a device different from that claimed.”

Nowhere does petitioner attempt to show that the doctrine of file wrapper estoppel was not correctly applied by the Court of Appeals.

Question 8 refers to a patent “which is outside of the prior art” while the Court of Appeals definitely and distinctly held (R. 398):

“In our view, this Kahn disclosure is of the prior art and when so considered it discloses the element relied upon for novelty in the instant patent.”

The circumstance that the Examiner allowed the limited claim over this prior art patent is of no controlling effect on the validity of the patent in court.

Question No. 12 (page 11) of the petition refers to the failure of one charged with infringement to testify about the prior art. The devices here involved are so simple and obvious that neither party deemed it necessary to offer expert testimony concerning the prior art. The prior patents are self-explanatory. Question 12 as stated by petitioner is, we submit, inconsequential, if not frivolous.

Question 13, petition page 11, refers to so-called unidentified secondary evidence produced by respondents as insufficient to sustain the defense of lack of novelty. This, however, must refer to the chart (Defts.' Exhibit 18a, Page 259 of Vol. I Book of Exhibits). This chart is a reproduction from patents and publications in the prior art for convenience in reference. Every prior patent and publication illustrated on this chart is in evidence as a part of Defts.' Ex. 12 (Vol. II of Exhibits). Nowhere does it appear that the Court of Appeals relied in any way on, or even referred to this chart. In overruling petitioner's objection to the chart as secondary evidence, the District Court (R. 317) held:

"It doesn't change the drawings as they appear in the patents at all. Of course, if they did, they would give way to the patents."

This question raised by petitioner is immaterial and inconsequential.

Error 14 (p. 17) criticizes the findings of fact and conclusions of law. The Court of Appeals in every instance has set forth its reasons for its rulings on each patent in suit. It explained the prior art, the points of novelty asserted and explained the grounds of its conclusions.

As contradistinguished from this, the District Court adopted the findings submitted by petitioner and did not state any specific reasons in support of its findings.

In *Hartford Empire Co. v. Shawkee Mfg. Co.*, 147 F. 2d 532, the Court (C.C.A. 3) said (535 with respect to a finding-of-fact):

“Its office is to distill from the evidence which has been adduced at the trial of a disputed issue the pertinent facts which must be known by the court in order to enable it to determine and apply the relevant rules of law and thereupon to grant appropriate relief to the litigants.”

No salvaging features over the anticipations, selections, and mere changes in degree over the prior art, which were specifically urged by respondents, are identified in the findings of the District Court. While stating that the patents in suit are not anticipated, they fail to point out differentia over the prior art.

The character of the findings of the District Court is such that they do not merit the regard due findings which should be followed “unless clearly erroneous” or which are not obviously determinable by the reviewing court from the prior patents.

These devices are so simple in construction and obvious in operation and result that neither party offered expert testimony to explain the prior patents. The reviewing Court was qualified to pass judgment on the undisputed disclosures in prior art without being bound by the findings of the District Court.

ARGUMENT.

Subject Matter of the Patents in Suit.

The Court of Appeals (R. 387) has clearly stated the general subject matter of the patents in suit and the prior art, where is said:

“Tie rods for supporting forms used in the construction of concrete walls were extremely old in the art. This is shown by scores of prior patents introduced by the defendants and relied upon as anticipating or showing a lack of invention in the patents in suit. There are many prior art patents which disclose, as do the patents in suit, ties extending through the form walls and the concrete, spacers for holding apart the sides of the form for the concrete, devices for holding the walls on the ties during the pouring of the concrete and means to break off the projecting ends of the ties after the concrete has set. The devices of all the patents in suit relate to ties, spacers and tie-holders, and it is contended by defendants that they utilize these old combinations of elements so as to perform the same old functions and to obtain the same or similar results.”

With respect to the prior art, the Court of Appeals (R. 388) said:

“Ties of different shapes—round wire and flat bars—were old. Spacers on the tie rod for the concrete form, in a wide diversity of detail, were old. Holders on the ties for the sides of the form in the form of wedges, screws, welded and integral members were old, as well as means for twisting or breaking off the rod in the concrete after the latter had hardened.”

Particularizing the subject matter of the patents in suit and the rulings thereon:

Patent No. 1,857,610 for welding pieces of wire on the rod to function as stops and a wedge for hold-

ing the form on the tie, was held invalid by the Court of Appeals for lack of invention, which reversed the District Court, which held them valid but not infringed.

Patent No. 1,919,751 is for the same wedge defined in Claim 2 of the first patent, and the Court of Appeals held this patent was void for double patenting.

Patent No. 2,020,919 is for upsets on the tie engaged by washers which engage the form. The Court of Appeals held the invention substantially anticipated by Pinaud Patent No. 2,095,714 (Ex. Book II 608) and that invention was lacking. Such upsets were also old in other patents.

Patent No. 2,107,130 is for securing a washer between two annular ribs on the tie in the concrete. The Court of Appeals held that the claim was limited by file wrapper estoppel and not infringed, and also that the washer and ribs on the rods were anticipated by Kahn Patent No. 768,284 (Ex. Book II 62). Non-infringement was admitted by plaintiff.

Patent No. 2,162,592 is for a washer with bumps or deformations. The Court of Appeals held invention was lacking in view of several prior art patents which exhibited formations for the same purpose.

Patent No. 2,222,393 is for a tie adapted to be pulled out of the concrete, which the District Court held valid but not infringed. It did not dismiss the complaint as to this patent. The Court of Appeals held the complaint should have been dismissed and without a finding of validity of this patent.

In *Lincoln Engineering Company v. Stewart-Warner Corp.*, 303 U. S. 545, 82 L. Ed. 1008 (1010) this Court said:

“And the improvement of one part of an old combination gives no right to claim that improvement in com-

bination with other old parts which perform no new function in the combination.”

It appears from the decision of the Court of Appeals that the patents in suit are for old combinations and old elements which perform no new function in the combinations. The petition does not point out how the old elements in the old combination perform any different function or achieve any new result.

Patent in Suit No. 1,857,610.

Plaintiff charged infringement of claims 1, 2 and 5. This patent exhibits the usual tie rod. Cross-pieces of wire are welded to the rod to serve as spacers for the form boards. Although plaintiff abandoned the charge of infringement in the findings submitted to the District Court, the claims were held valid but not infringed, after respondents had introduced the prior art to establish anticipation and lack of invention.

The Court of Appeals held that the tie rod and mere welding of pieces of wire thereon as stops for the form boards, was lacking in invention “either with or without any prior art” (R. 390). Anticipation is clearly shown by the prior patent to Alley, No. 1,746,298 (Vol. II Book of Exhibits, 480), and others, which were not mentioned in the opinion of the Court of Appeals.

The Court of Appeals also held that the criteria for producing an alleged brittleness in the rod specified in claims 1 and 5 were not disclosed (R. 390) in the patent and that the claims were void for lack of such disclosure. Plaintiff’s President admitted this lack of disclosure and said it would “disclose the secrets of the business” (R. 391).

The petition fails to assert any error in or any ground for review of patent in suit, No. 1,857,610, as to its invalid-

ity, or for lack of invention and, therefore, we assume that this court will give no consideration to this issue.

Patent in suit, No. 1,857,610, discloses on the tie, a wedge for holding the form boards, which the specification of the patent described as "bottom heavy" or having a preponderance of metal below its midpoint. Claim 2 of this patent specifies this "bottom heavy" wedge. The District Court held this Claim 2 valid but not infringed.

The Court of Appeals held this Claim 2 in Patent No. 1,857,610, which specified this wedge, rendered invalid for double patenting, the claims of the second patent in suit, No. 1,919,751, for the same wedge.

The disclosure of this wedge and claim 2 in the first patent in suit [No. 1,857,610] are the basis of the decision of the Court of Appeals that the second patent in suit [No. 1,919,751] is void for "double patenting".

Patent in Suit No. 1,919,751.

This patent No. 1,919,751 (Vol. I Ex. Book, p. 24) in Figs. 1, 2, 3 and 4, illustrates the *identical* tie and wedge exhibited (Vol. I of Ex. Book, p. 2) in Figs. 1, 2, 3 and 4 of patent in suit No. 1,857,610.

Both patents contain an *identical description* of the wedge.

Claim 2 of Patent No. 1,857,610 includes this wedge and defines it as "bottom heavy", which is asserted to be its distinctive structural characteristic.

The claims of Patent No. 1,919,751 define and describe the *identical* wedge illustrated, described and claimed in the earlier patent.

The claims of the second patent are predicated on the same "bottom heavy" wedge as claim 2 of the first pat-

ent. The claims of the second patent merely add the enlarged portions or the specific details which are present in and are necessary to render "bottom heavy" the wedge defined in claim 2 of the first patent. The differences in the claims of the two patents are mere matters of language or description applicable to the same wedge and are not for separate or distinct inventions in the same wedge. The claims of both patents are predicated on and cover the *identical* wedge.

The second patent, if valid, prolongs petitioner's monopoly for the wedge beyond the term of the first patent. That is the basic vice of double patenting, and upon these premises the Court of Appeals held the second patent was void for double patenting (R. 392).

The Court of Appeals cited *Miller v. Eagle*, 151 U. S. 186, 198, 38 Law Ed. 121, 127, which held:

"The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ * * * it [later patent] must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims in each patent. * * * The matter sought to be covered by the second patent is inseparably involved in the matter embraced in the former patent, and this, under the authorities, renders the second patent void".

The claims of petitioner's second patent differ only from Claim 2 of the first patent in the language or scope of the claims applied to the same wedge. The details specified in the claims of the second patent are inseparable from the wedge defined in Claim 2 of the first patent.

The Court of Appeals held (R. 391):

"When the drawings and specifications of the latter patent are taken into consideration, we find the iden-

tical wedge described in the claims of patent No. 1,919,751."

The Court of Appeals in holding petitioner's second patent void followed the foregoing authority of this court.

Nowhere in the petition does the petitioner attempt to show that the differences in the language of the claims define separate or distinct inventions, or that the monopoly of the first patent under Claim 2 would not be unlawfully prolonged by the second patent, if valid.

Copendency of the applications referred to by petitioner (Brief pp. 5 & 6) does not salvage the second patent from "double patenting" because whatever invention may be asserted for the same wedge, it was indivisible. The District Court referred to no authority in support of its decision on this point. There was no requirement for division by the Patent Office.

Additionally respondents urged as grounds for invalidity and lack of invention of the claims of patent No. 1,919,751, Colt Patent No. 1,552,912 (Vol. II Ex. Book 320) which shows a "bottom heavy" wedge and Hagen patent No. 1,743,915 (Vol. II of Ex. Book 476) and Hearn patent No. 1,579,764 (Vol. II of Ex. Book 430). The Court of Appeals, in view of double-patenting, did not rule on these other defenses.

Patent in Suit No. 2,020,912.

The alleged novelty of this patent is asserted to be in the upset collars or bulges on the tie to function as stops for the washers in lieu of other forms of stops or spacers. These upsets were old in the art, as exemplified by Fahrney Patent No. 921,211 (Ex. Book II, p. 134), LaMorte Patent No. 1,765,729 (Ex. Book II, p. 480), the publication of Central States Tie (Ex. Book I, p. 255a) and Pinaud

Patent No. 2,095,714 (Ex. Book II, p. 608) which was applied for prior to the application for patent in suit No. 2,020,912.

The Court of Appeals without reference to any of these except said Pinaud patent held (R. 394):

“Pinaud, in our judgment, comes close to being a complete anticipation. It discloses a tie rod, integral collars or upsets on the rod, and washers engaging the stops and the inner side of the form; slitted portions of the rod in the body of the concrete at which the ends of the tie are broken off. It shows a flat washer maintained against upsetting portions formed on the rod. There, as here, the rods are twisted off within the body of the concrete, the spacers or upsets integral with the rod and the washers are spaced on the rod by the upsets. The Pinaud patent was not cited by the Patent Office.”

Question 6 (p. 10) and petitioner's brief (p. 28) refer to the use of Pinaud Patent No. 2,094,814, as a prior publication. This prior patent was not used as a prior publication. By reason of its filing date earlier than any date established by the patentee of No. 2,020,912 Pinaud establishes that said patentee was not the first inventor.

The application for the Pinaud patent was filed in the Patent Office April 21, 1934 (Ex. Book II, p. 609). Schenk patent in suit, No. 2,020,912, was applied for May 31, 1934 (Ex. Book I, p. 49). The prior filing date of Pinaud establishes the earlier date of invention, in the absence of evidence carrying the date of the invention of patent No. 2,020,912 back of Pinaud's filing date. Schenk was not the first inventor. No such evidence was offered. The later issue of the Pinaud patent, or that the Pinaud patent is not a prior publication, are immaterial. Under the rule established by this court in *Milburn Co. v. Davis Bournonville Co.* in 270 U. S. 390, 70 L. Ed. 651, the prior filing of

an application establishes the defense that the later applicant was not the first inventor.

Prior knowledge, as shown by the Pinaud patent was pleaded (R. 44). In the District Court and the Court of Appeals petitioner did not challenge the availability of Pinaud's earlier filing date to establish that Schenk was not the first inventor. It relied on alleged differences which the Court of appeals overruled where it held the Pinaud patent was a substantially complete anticipation.

The Court of Appeals specifically mentioned Pinaud Patent No. 2,095,714, but there are several other defenses of invalidity which were not mentioned by that court, because they were not necessary and cumulative. The Court of Appeals said (R. 396):

"The break-off element adds nothing to the novelty of the claims and this is so with or without the prior art. It consists of nothing more than a cut or indentation in the wire at the point desired, which inevitably weakens it at that point".

Defendants' Exhibit 9a, reproduced on pages 255 and 255a of Vol. I of Exhibits, is a publication issued July 31, 1931 by the *Central States Manfg. & Engineering Company of Kansas City, Kan.*, (R. 286, R. 293) prior to the application date (May 31, 1934) for patent No. 2,020,912. This publication exhibits a tie rod with upset collars or bulges and washers engaging the collars substantially the same as the tie rod, collars and washers claimed in Patent No. 2,020,912, with the single exception that it does not disclose the break-off notches which the Court of Appeals held, in the foregoing quoted statement, added nothing to the novelty of the claims. In *Kinninger et al. v. Emerson Co.* (62 Fed. Sup. 545) Patent No. 2,245,559, which claimed these break-offs inwardly of the outer surface of a wall, was held invalid.

The Pinaud patent is but one of several instances in the prior art which establish anticipation or lack of invention in the claims of patent in suit, No. 2,020,912.

Additionally, the Court of Appeals held (R. 395) that their patent in suit failed to disclose how the tie was strengthened at the upsets, according to the claims. The petition does not challenge that finding.

Patent No. 2,107,130.

The file wrapper proceedings (Ex. Book I, p. 90) which resulted in the allowance of the single claim specifically limited to a disk or a washer held on the rod by—

“ * * * an annular raised rib integrally formed on the rod on *each* side of the disk ”

have been fully pointed out by the Court of Appeals (R. 397).

Petitioner's President Snyder admitted that defendants' tie rod did *not* infringe and does not function like the patent, as pointed out by the Court of Appeals (R. 399).

With respect to petitioner's claim that defendants' device infringes, the Court of Appeals said (R. 398):

“ The fallacy of this argument is evident when it is considered that claims which are sufficiently broad to cover such a construction were rejected and that the claim as allowed was specifically limited in the manner above indicated. ”

The District Court apparently disregarded the file wrapper history, while the Court of Appeals held that patentee (R. 400):

“ * * * is now estopped from asserting infringement on a device different from that claimed, even though under different circumstances it might constitute infringement under the doctrine of equivalency ”

citing the decisions of this court in *Knapp v. Morse*, 150 U. S. 221, 224 and *Hubbell v. United States*, 179 U. S. 77, 80.

Nowhere in the petition does petitioner point out any error in the application of the doctrine of file wrapper estoppel which the Court of Appeals cited.

The District Court did not mention the file wrapper history in its findings.

Upon Kahn Patent No. 768,284 (Ex. Book II, p. 62) the Court of Appeals held Patent No. 2,106,130 invalid and said (R. 398):

"In our view this Kahn disclosure is of the prior art and when so considered it discloses the element relied on for novelty in the instant patent."

Patent in Suit No. 2,162,592.

This patent is for a cone-shaped washer or spacer designed for forming a socket or depression in the concrete wall and around the end of the rod.

The Court of Appeals held (R. 400):

"That cones for such purpose were an old expedient is not open to doubt. The sole novelty asserted for this claim is that it provided for 'a conical concrete-contacting face provided with a plurality of spaced projections pressed out of the body of the disk [cone] * * * whereby a plurality of spaced recesses or pockets free from communication with either the inner or outer ends of the depression formed in the wall will be produced in said depression for the reception of pointing concrete'."

As the Court of Appeals pointed out (R. 401) the formation of pockets or recesses in the wall by contours on the cones for the same purpose were old in McCarty patent No. 915,955 (Ex. Book II, p. 108), Whitescarver patent No. 1,665,649 (Ex. Book II, p. 400), and Ander-

son patent No. 1,950,008 (Ex. Book II, p. 560). The Court of Appeals said with respect to Whitescarver (R. 401):

“Here again is a disclosure of the idea relied upon for invention in the instant patent.”

From the decision of the Court of Appeals it is clearly apparent that there is no invention in a mere change in the shape of the formations on the cone. During the pendency of the application for this patent, the Examiner (Ex. Book I, p. 109) said:

“It is axiomatic that it does not amount to invention to shape any molding surface so that it will have the proper contour to give the desired shape to the molded product. Once having the design of the surface desired in the depression molded by a spacer cone, it is obvious to shape the molding surface of the cone accordingly.”

The Examiner further held (Ex. Book I, p. 12):

“* * * such differences as exist between applicant's spacing disc and that of Whitescarver are held to be merely matters of design since no improvement or change in function is accomplished.”

Nowhere in the petition has petitioner attempted to point out that the slight differences in the shape of the formations on the washer are of any mechanical consequence or inventive.

Patent in Suit No. 2,222,339.

The petition apparently seeks no review with respect to this patent and for that reason it may not be considered by this court. There is, however, an obvious error in the petition concerning the ruling of the Court of Appeals.

The District Court, after petitioner's admission that respondents had not infringed, entered judgment that

this patent was valid (R. 349, p. 2) but did *not* dismiss the complaint as to that patent. The only reference to this patent in the judgment was that it was valid. The validity of the patent was not litigated and plaintiff's admission of non-infringement rendered the question of validity moot.

Because the District Court did *not* dismiss as to this patent, the Court of Appeals held (R. 402):

"Defendants contend that plaintiff's concession of non-infringement rendered the question of invalidity moot and that the complaint as to this patent should have been dismissed. The authorities relied upon support this contention."

Reversal was adjudged in accordance with the rule laid down by this court in *Electrical Fittings Corp., et al., v. Thomas & Betts Co., et al.*, 307 U. S. 241-242. When there is no infringement, the complaint should be dismissed, which the District Court did not do.

CONCLUSION.

For the foregoing reasons we respectfully submit that the Petition for the Writ of Certiorari should be denied.

Respectfully submitted,

FRED GERLACH,
NORMAN H. GERLACH,

Counsel for Respondents.